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December 23, 2003

TO (FIRM): United States Patent And Trademark Office, Group Art Unit: 2655
ATTN: Examiner: Jorge L. Ortiz Criado

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FROM: James G. McEwen *Jm*

Re: U.S. Patent Application
Serial No.: 09/844,697
For: ERROR SIGNAL DETECTION APPARATUS AND METHOD FOR OPTICAL
RECORDING/REPRODUCING SYSTEM
Inventor(s): Byung-in MA et al.
Our Docket: 1293.1204

NO. OF PAGES (Including this Cover Sheet) *4*

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COMMENTS:

RESPONSE TO RESTRICTION REQUIREMENT

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I hereby certify that this correspondence is being transmitted via facsimile to: Commissioner for Patents,
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on *Dec 23*, 2003

By: *[Signature]*
STAAS & HALSEY

Date: *Dec 23, 2003*

Docket No.: 1293.1204

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Byung-in MA et al.

Serial No. 09/844,697

Group Art Unit: 2655

Confirmation No. 9532

Filed: April 30, 2001

Examiner: Jorge L. Ortiz Criado

For: ERROR SIGNAL DETECTION APPARATUS AND METHOD FOR OPTICAL
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KRESPONSE TO RESTRICTION REQUIREMENTCommissioner for Patents
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Sir:

This is responsive to the Office Action mailed November 24, 2003, having a shortened period for response set to expire on December 24, 2003, the following remarks are provided.

I. Provisional Election of Claims Pursuant to 37 CFR §1.142

Applicants provisionally elect Species B in response to the preliminary restriction requirement set forth in the Office Action. It is respectfully believed that claims 1, 2, 5, 6, 8, 9, 11-13, 16, 17, 19, 20, 22-25, 27-39, 41, 42, and 44-46 includes and or are generic to Species B as defined by the Examiner.

Moreover, the Examiner asserts on page 2 of the Office Action that that no claims are considered generic. However, in reviewing the claims, it is believed that at least claims 1, 12, 35, and 44 are generic to Species A through F as at least claims 1, 12, 35, and 44 are not limited to a row of the summed signals as in Species A and C, do not recite a gain feature as in Species B and E, do not recite whether additional signals are summed and then phase compared as in Species D, E, and F, and do not recite a delay feature as in Species F. As such, it is respectfully submitted that at least claims 1, 12, 35, and 44 are generic to the Species A through F, which are variously recited in claims depending therefrom. It is further respectfully submitted that depending claims 8, 11, 19, 22-24, 27-34, and 36 are deemed generic to Species A through F for similar reasons.

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II. Applicants Traverse the Requirement

As an initial point, it is noted that the Examiner in requiring election between species pursuant to 35 U.S.C §121, but has not identified which claims belong to which species of the invention. As such, it is respectfully submitted that the Examiner's action is not compliant with the requirements of 35 U.S.C. §121, which requires an identification of claims that fall into particular groups. As noted by the Federal Circuit:

Section 121 can extend the patent term for inventions that are not patentably distinct, as apparently would be the case here. Given the potential windfall such patent term extension could provide to a patentee, this court applies a strict test for application of § 121. Specifically, § 121 only applies to a restriction requirement that is documented by the PTO in enough clarity and detail to show consonance. The restriction documentation must identify the scope of the distinct inventions that the PTO has restricted, and must do so *with sufficient clarity to show that a particular claim falls within the scope of the distinct inventions*. In other words, § 121 requires a record that shows a discernable consonance." (italics added).

Geneva Pharmaceuticals, Inc. v. GlaxoSmithKline PLC, No. 02-1439 (Fed Cir. November 21, 2003).

As the Examiner's demarcation of the inventions does not specify which claims belong to which groups, it is respectfully requested that the Examiner's election requirement between species does not comport with the notice requirements of 35 U.S.C. §121 to show a discernable consonance.

Additionally, the Examiner asserts that applicants must elect between species drawn to a FIG. 5 (Species A), FIG. 6 (Species B), FIG. 7 (Species C), FIG. 12 (Species D), FIG. 13 (Species E), and FIG. 14 (Species F). As noted in MPEP 806.04(a), "37 CFR 1.141 provides that a *reasonable number of species* may still be claimed in one application if the other conditions of the rule are met" (italics added). Consistent with the requirements in MPEP 803 and 808, the Examiner needs to provide a rationale as to why an election is required or how, without the election; the Examiner is unduly burdened in comparison with the burden visited on the applicants in the extra delay and expense in obtaining protection for each Species.

The Examiner has not provided evidence that the Examiner will experience an undue burden in searching and examining the invention set forth in Species A through F. Specifically, the Examiner has not provided evidence that the existence of six (6) species represents an unreasonable number of species as defined by the Examiner to be searched, and has not provided a rationale as to why the invention is to be separated into Species A through F. As

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such, it is respectfully submitted that the Examiner has not presented sufficient evidence of a burden on the Examiner in examining Species A through F which is out of proportion with the delay and expense visited on the applicants in protecting the invention recited in Species A and C through F so as to show an undue burden on the Examiner or an unreasonable number of species so as to also require an election between these species. Therefore, it is respectfully requested that the Examiner reconsider and withdraw the election.

III. Conclusion

Upon review of references involved in this field of technology, and when all of the other various facts are taken into consideration, it is believed that upon reconsideration of the Examiner's initial restriction requirement, all of the pending claims should be examined in the subject application.

If any further fees are required in connection with the filing of this Response, please charge the same to our deposit account number 19-3935.

Should any questions remain unresolved, the Examiner is requested to telephone Applicants' attorney.

Respectfully submitted,

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By: 

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